

REMARKS/ARGUMENTS

The Office Action mailed April 27, 2004, and the references cited therein have been received and carefully reviewed in light of the Examiner's helpful comments and suggestions.

As a result of the Office Action, claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 5,720,537 to Lutz in view of FR 723340. These references have been carefully reviewed but are not believed to show or suggest Applicant's invention as now claimed. Reconsideration and allowance of claim 1 is respectfully requested in view of the following remarks.

First, according to MPEP 2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitation must be taught or suggested by the prior art. Claim 1 has been amended which now requires oblique sides (6), which have oppositely direct equal inclinations in relation to the bottom (5) to have an angle of less than 90°. Lutz teaches a bar notch 32 in a side member 10, wherein the bar notch 32 includes a plane bottom which is parallel with the side surface in the side member and two equally long oblique sides with oppositely directed and equal inclinations in relation to the bottom. However, the inclined sides having an inclination of great 90°, wherein the two sides in a notch are diverging, and not converging as the notches in the claimed invention. To create such a bar notch in accordance with the claimed method preliminary shearing or punching of the side member at a first depth from a side surface, the side surface of the knives will create an overcut or cutout behind the sides desired in the final shear and with an edge. Hence, the bar notch no longer has a correct dimension or shape.

Second, according to MPEP 2141.01 (a), to rely on a reference under 35 U.S.C. 103, it must be analogous prior art. That is, in order to rely on a reference as

a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned. FR 723340 teaches and is related to a method of perforating the side of a cinematographic film. Unquestionably, this substantial difference in intended use as well as having different classifications, should be considered as evidence that the cited reference is non-analogous art.

Even if, for the sake of argument, this reference is considered, it teaches a preliminary punch being performed in a machine with a die plate and punch with outer dimensions that are a little less than the holes to be punched. The film strip is moved to another machine or another part of the machine thereafter which incorporates the die and a punch with dimensions which are equal to the dimensions of the holes to be punched in the film strip. However, the claimed invention requires only one set of tools and the workpiece does not have to be moved from one machine to another or from one part of the machine to another part.

Third, Applicant respectfully submits that the Examiner has not provided a legally tenable "motivation" or "suggestion" to combine the teachings of those references. The sole evidentiary support that was provided to demonstrate the alleged motivation in the prior art to combine these teachings is as follows:

"Therefore, it would have been obvious to one having ordinary skill in the art, at the time of the invention, to have provided Lutz with a method of producing joints, as taught by FR 723340, to allow for an alternate method of forming the individual joint connections." *Office Action*, Page 3.

However, according to MPEP 2143.01, "[t]he level of skill can not be relied upon to provide suggestion to combine references." In absence of specific motivation or suggestion taught by the prior art (See MPEP 2143: "The teaching and

suggestion to make the claimed combination and the reasonable expectation of success must be both found in the prior art, and not in applicant's disclosure."), the obviousness rejection appears to have been improperly based solely upon the level of skill in the art.

Fourth, the fact that the prior art could be modified does not make such combination obvious in the absence of the prior art suggesting the desirability of doing so. *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984). Here, the Examiner has provided no clue as to where support is found for the reasoning set forth as the suggestion to combine the references, and therefore it stands merely as the Examiner's unsupported opinion to state that the combination would "allow an alternate method of forming individual joint connection." That is to say, why one of ordinary skill in the art would have been led to combine the teachings of the Lutz reference with the teachings of the FR 723340. None is expressed in the references, and thus it would appear that the only motivation for doing so is found in the hindsight afforded in viewing the Applicant's disclosure. In viewing of the foregoing remarks, it is respectfully submitted that claim 1 is patentable over the prior art combination.

Each issue raised in the Office Action mailed April 27, 2004, has been addressed and it is believed that claim 1 is now in condition for allowance. Wherefore, Applicant respectfully requests a timely Notice of Allowance be issued in this case.

Respectfully submitted,
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